



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/037,916 03/10/98 NISHIO

N P8287-8002

EXAMINER

TM02/0118

ARENT FOX KINTNER PLOTKIN & KAHN, PLLC  
1050 CONNECTICUT AVENUE, N.W., SUITE 600  
WASHINGTON DC 20036-5339

SPRING H

ART UNIT

PAPER NUMBER

2161

DATE MAILED:

01/18/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. 09/037,916	Applicant(s) NISHIO ET AL.	
	Examiner Hyung S. Sough	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2000.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 13-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 13-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/10/98 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

#### Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 2161

***Drawings***

1. The drawings are objected to because they are informal. Refer to PTO Form 948 (Paper No. 5). The drawings are further objected to by the Examiner for the following reasons:

- They do not comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "S1504" (see page 40, lines 3 and 9).

- In FIG. 36, next to the step T413, should "TO STEP T402 IN FIG. 35" be --TO STEP C402 IN FIG. 35--?

**Applicant is advised to carefully review all the drawings for further needed corrections.**

2. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

***Specification***

3. The disclosure is objected to because of the following informalities: .

- Page 55, line 3, should "display 402" be --display 502--?
- Page 66, line 23, should "back" be --bank--?
- Page 70, lines 19-24, the statement, i.e., "when the correlation ... mode or not.", is contradicting to the FIG. 35. More specifically, contrary to the statement that "If it is determined

Art Unit: 2161

in step C407 that the area read in step C404 is the first purse, the processing shifts to step C408", in FIG. 35, if it is determined in step C407 that the area read in step C404 is **not** the first purse, i.e., "No" in FIG. 35, then the processing shifts to step C408. Further, the statement from line 25 of page 70 to line 12 of page 71 cannot be clearly understood.

**Applicant is advised to carefully review the entire specification for further needed corrections.**

***Claim Rejections - 35 U.S.C. § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification, as originally filed, does not provide support for the invention as is now claimed, i.e., an electronic purse system having a first terminal group which can transfer money to an IC card, wherein each terminal in the first group includes a first ciphering/deciphering unit and a second terminal group which does not perform ciphering/deciphering of the information related to money. More specifically, the specification,

Art Unit: 2161

as originally filed, does disclose an electronic purse system having either **the first group and the IC card or the second group and the IC card, not an electronic purse system having the first terminal group, the second terminal group and the IC card as is now claimed.**

***Claim Rejections - 35 U.S.C. § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Read (EFTPOS: electronic funds transfer at point of sale: ELECTRONICS & COMMUNICATION ENGINEERING JOURNAL NOVEMBER/DECEMBER 1989, pp 263-270) in view of Harrop (New electronics for payment: IEE REVIEW OCTOBER 1989, pp 339-342)

**Re claim 13**, Read discloses an electronic purse system having all of the features claimed except for the second terminal group which does not perform ciphering/deciphering of the information related to money: *a first terminal group (i.e., ATM) which can transfer money to an IC card; wherein each terminal in the first group includes a first ciphering/deciphering unit (i.e., encryption/decryption system); (2) a second terminal group (i.e., telephone); and an IC card including a first purse (i.e., a secret level), a second level (i.e., a free level), and a second*

Art Unit: 2161

*ciphering/deciphering unit (i.e., encryption/decryption system) for the first purse.* However, as shown by Harrop, it is well known in the art to use a prepayment card for payphones and the prepayment card does not perform ciphering and deciphering of the information related to money. Thus, it would have been obvious to one of ordinary skill in the art to modify the electronic purse system of Read by adopting the teaching of Harrop (i.e., by replacing the second level of Read with the prepayment phone card of Harrop) to facilitate the use of the smart card by eliminating ciphering/deciphering steps for a transaction which does not require high security. Further, the electronic purse system of Read modified by Harrop would inherently work as claimed, i.e., performing cipher/decipher the information for the transaction between the first terminal group and IC card and without performing cipher/decipher the information for the transaction between the second terminal group and IC card.

**Re claims 14-19,** Read discloses an IC card having all of the features claimed except for the explicit disclosure of making a payment from the second purse without performing ciphering/deciphering of the information related to money: *an IC card including a first purse (i.e., a secret level) having a first ciphering/deciphering means (i.e., encryption/decryption system) and a second level (i.e., a free level) and a second level (i.e., a free level).* However, as shown by Harrop, it is well known in the art to use a prepayment card for various terminals (i.e., payphones, vending machines and ticket machines) and the prepayment card does not perform ciphering and deciphering of the information related to money. Thus, it would have been obvious to one of ordinary skill in the art to modify the IC card of Read by adopting the teaching of Harrop (i.e., by

Art Unit: 2161

replacing the second level of Read with the prepayment card of Harrop) to facilitate the use of the smart card by eliminating ciphering/deciphering steps for a transaction which does not require high security. Further, the IC card of Read modified by Harrop would inherently work as claimed, i.e., performing cipher/decipher the information for the transaction between the first terminal group and IC card and without performing cipher/decipher the information for the transaction between the second terminal group and IC card. Still further, a recitation of the intended use of the claimed invention (e.g., "for storing a first amount of money") must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use (e.g., EEPROM used for making the IC card of Read), then it meets the claim.

### *Response to Arguments*

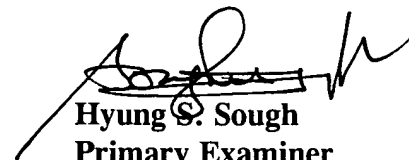
8. Applicant's arguments with respect to claims 13-19 have been considered but are moot in view of the new ground(s) of rejection.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hyung S. Sough whose telephone number is (703) 308-0505. The Examiner can normally be reached Monday-Friday from 8:30 AM - 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, The Examiner's Supervisor, James P Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)305-3900. The Group Fax number is (703) 308-1396.

Art Unit: 2161



**Hyung S. Sough**  
**Primary Examiner**  
**Art Unit 2161**

shs  
January 13, 2001